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**Patent and Trademark Office**

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/441,832

11/17/99

LAWSON

C

2870/192

026646

HM12/0821

EXAMINER

KENYON & KENYON

ONE BROADWAY

NEW YORK NY 10004

BERMAN, A

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

08/21/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09/441,832

Applicant(s)

LAWSON ET AL.

Examiner

Alysia Berman

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1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 4-6, 20, 22 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-19, 21, 23, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 6.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

1. Receipt is acknowledged of the amendment filed July 10, 2001. Claims 1, 2, 9, 15 and 16 have been amended. Claims 1-26 are pending.

### ***Election/Restrictions***

2. Applicant's election with traverse of species (b), sterol-based surfactant/emulsifier, in Paper No. 5 is acknowledged. The traversal is on the ground(s) that the composition claims relate to the same indivisible invention of a non-emulsion topical gel composition and that a slight modification in the type of surfactant or emulsifier does not change the nature of the invention. This is not found persuasive because a reference anticipating or rendering obvious a composition comprising a sterol-based surfactant/emulsifier would not necessarily anticipate or render obvious a composition comprising a carbohydrate-based surfactant/emulsifier. Different types of surfactants and emulsifiers behave differently in different types of composition. One skilled in the art would not necessarily expect a sterol-based surfactant/emulsifier to behave the same as a carbohydrate-based surfactant/emulsifier. Therefore, a separate search and examination would have to be conducted for each species, which would be burdensome to the Examiner.

If Applicant wishes to state on the record that the species are equivalent, the election will be withdrawn. However, the examiner would then be justified in rejecting one species over the other.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 4-6, 20, 22 and 24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species of the invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 5.

4. This application contains claims drawn to an invention nonelected with traverse in Paper No. 5. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 7, 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. The terms "carbohydrate-based" and sterol-based in the claims are vague and indefinite. This rejection is maintained for reasons of record in paper no. 3.

#### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 2, 7-11 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,567,420 (420).

This rejection is maintained for reasons of record in paper no. 3.

10. Claims 1, 2, 7-11 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,747,049 (049).

This rejection is maintained for reasons of record in paper no. 3.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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13. Claims 1, 2, 7-11, 14-17, 21, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over either US 5,567,420 (420) or US 5,747,049 (049) each.

These rejections are maintained for reasons of record in paper no. 3.

14. Claims 3 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over either US '420 or US 049 each as applied to claims 1, 2, 7-11, 14-17, 21, 23 and 25 above, and further in view of US 5,242,070 (070).

This rejection is maintained for reasons of record in paper no. 3.

15. Claims 12, 13, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over either US '420 or US '049 each as applied to claims 1, 2, 7-11, 14-17, 21, 23 and 25 above, and further in view of US 5,741,499 (499).

This rejection is maintained for reasons of record in paper no. 3.

16. Claims 12 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over either US '420 or US '049 as applied to claims 1, 2, 7-11, 14-17, 21, 23 and 25 above, and further in view of US 5,393,526 (526).

This rejection is maintained for reasons of record.

### ***Response to Arguments***

17. Applicant's arguments filed July 10, 2001 have been fully considered but they are not persuasive.

18. Applicant argues that the Declaration provides the post office address of each inventor. However, the post office address for Isaac D. Cohen is omitted. If the

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inventor's post office address and residence are the same, the Declaration should so

state. *However, in view of MPEP 602.03, this requirement is hereby waived.*

19. Applicant argues that sterol-based surfactants are described at page 4 of the specification and one of ordinary skill in the art understands what sterol-based means. However, a fair review of the specification at page 4 did not turn up an exclusive definition of sterol-based surfactants. In fact, the definition at page 4 actually lends to the indefiniteness of the term because it recites derivatives but does not further define the derivatives. Therefore, it is unclear what is included and excluded from the term sterol-based and the metes and bounds of the claims cannot be determined.

20. Applicant argues that US '420 fails to disclose a water containing non-emulsion gel as instantly claimed. Although emulsions are disclosed as a preferred embodiment in the '420 patent, the patent is not exclusively limited to emulsions. US '420 discloses that the compositions may be in various forms including gels (col. 3, lines 36-38 and claim 1). It is known in the art that gels are not conventionally in the form of emulsions. Additionally, gels are listed separately from water and oil emulsion type forms of the compositions. Therefore, one of ordinary skill in the art would understand from the teachings of US '420 that the compositions may be in the form of emulsions or gels.

21. Applicant argues that US '049 fails to expressly disclose the details of a gel type composition or the gel of the instant invention with specific components. US '049 discloses that the compositions may be in various forms including gels. US '049 discloses gels separately from water and oil two phase systems, i.e. emulsions. A reference is not required to exemplify each and every element of a claim but merely to

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disclose each and every element, which US '049 does. Applicant has not provided any limitations in the claims to distinguish over the prior art.

22. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a mousse-like gel) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

23. Applicant argues that a prima facie case of obviousness is rebutted by the unexpected properties of the present invention. However, Applicant has not provided any evidence or data supporting the allegation of unexpected properties.

24. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, substituting sodium behenate as taught by US '070 for sodium stearate in either US '420 or US '049 is motivated by the disclosure in US '070 that these two compounds are equivalent and one would expect similar results.

25. Applicant argues that US '499 teaches away from the present invention that includes a surfactant/emulsifier and a polyhydric alcohol. US '499 is used merely to



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show that it is known in the art to use isoprene glycol and silicone coated pigments in topical mousse compositions. It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose. *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). The idea of combining them flows logically from their having been individually taught in the prior art. *In re Crockett*, 279 F.2d 274, 276-77, 126 USPQ 186, 188 (CCPA 1960). The references are directed to the same field of endeavor, cosmetics, and are solving the same problem, prevention of skin aging.

26. Applicant argues that US '526 fails to remedy the defects of US '420 and US '049 of not teaching a non-emulsion gel. As stated above, both US '049 and US '420 teach non-emulsion gel compositions that may contain all of the components instantly claimed. US '526 is merely used to show that it is known in the art to use dimethicone coated pigments in cosmetic compositions.

### **Conclusion**

27. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached on Monday through Friday from 8:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 or 703-305-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.

  
Alysia Berman  
Patent Examiner  
August 15, 2001

  
DIANA DUDASH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600